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ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			ROSEN, NICHOLAS D	
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/528,528	AHN, HEE-JUNG	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 March 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 18 March 2005 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/18/2005.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

Claims 1-23 have been examined.

### ***Claim Objections***

Claims 1-4 are objected to because of the following informalities: In the third line of claim 1, and in the thirteenth and fourteenth lines (lines 4, 14, and 15 on page 24), reference is made to a “wired/wireless network”. This is ambiguous, in that it could be interpreted as either a network that is both wired and wireless, or a network that could be either wired or wireless. For examination purposes, the latter interpretation is assumed. In the twelfth and thirteenth lines of claim 1 (lines 13 and 14 on page 24), “accessed to” is objected to as odd and unidiomatic English; Examiner suggests “accessing,” or whatever other term(s) will best convey Applicant’s intended meaning. In the fourteenth and fifteenth lines of claim 1 (lines 15 and 16 of page 24), the usage of the word “on” is objected to as unclear and not idiomatic English (“on the purchase” and “on the electronic gift certificates”). Appropriate correction is required.

Claim 3 is objected to because of the following informalities: In the sixteenth and final line of claim 3, “the message format” technically lacks antecedent basis. (Claim 2 recites “a message format”, but claim 3 does not depend from claim 2.) Appropriate correction is required.

Claim 4 is objected to because of the following informalities: In the fifteenth and final line of claim 4, “the message format” technically lacks antecedent basis. (Claim 2

recites "a message format", but claim 4 does not depend from claim 2.) Appropriate correction is required.

Claims 5-9 are objected to because of the following informalities: In the fourth and fifth lines of claim 5, "through wired and wireless networks" is ambiguous, in that it could be taken as meaning that all requests through both wired and wireless networks, or that requests may pass through a wired network, a wireless network, or both. The latter interpretation is assumed for examination purposes. Also, there are two periods after the numeral "5" at the beginning of claim 5, where there should be only one. Appropriate correction is required.

Claims 10-14 are objected to because of the following informalities: In the fourth and fifth lines claim 10, "through wired and wireless networks" is ambiguous, in that it could be taken as meaning that all requests through both wired and wireless networks, or that requests may pass through a wired network, a wireless network, or both. The latter interpretation is assumed for examination purposes. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 7 recites "a number of sheets." There is reference to "a number of sheets" in the specification (page 14, lines 4-8, page 15, lines 11-14, and page 19, lines 2-5), but it is nowhere made clear how an electronic gift certificate, such as is recited in claim 5, upon which claim 7 depends, has a number of sheets

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 is indefinite in that it can plausibly be interpreted as reciting either a process of a user purchasing a gift certificate for a price, or of a user buying a product or service with a gift certificate. Furthermore, regarding the fourth element of claim 4 (ninth and tenth lines of claim 4; lines 8 and 9 of page 26), it is not clear what it means to allow the usage to process the settlement. Yet further, "the user" should normally be taken to refer to the same user as in claim 1, upon which claim 4 depends, but a question arises as to whether "the user" in claim 4 could be someone else to whom the gift certificate is transferred.

Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite in that it appears to be directed

to buying an electronic gift certificate, but the recitation of “the electronic gift certificate bought by the user” in the eighth and ninth lines of claim 5 (lines 22-23 on page 26) raises the question of whether a gift certificate has already been bought.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites that the message format includes the SMS and MMS format. This could be interpreted as reciting that the message format of a message includes both, which would be difficult, or that the message form could be either SMS or MMS.

Claims 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 is indefinite in that it can plausibly be interpreted as reciting either a process of a user purchasing a gift certificate for a price, or of a user buying a product or service with a gift certificate. Furthermore, regarding step (d), it is not clear what it means to allow the usage to process the settlement. Complicating the interpretation further, claim 16 recites, “performing a gift certificate buying process when the user has no gift certificate in (b),” suggesting that the claims are directed to buying a gift certificate, at least in some cases, while claim 23 recites the user buying a desired product at an online shop, implying that a gift certificate is applied to making a purchase.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 17 recites that the message format includes the SMS and MMS format. This could be interpreted as reciting that the message format of a message includes both, which would be difficult, or that the message form could be either SMS or MMS.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 recites, "the online shop including an online shopping mall." It is ambiguous whether this is intended to be a claim limitation that the online shop includes an online shopping mall, or a permissive statement that the online shop can be an online shopping mall. Furthermore, an online shop would not normally include an online shopping mall; it might be included in one.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

### **Claims 1-4**

Claims 1, 2, 3, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of official notice. As per claim 1, Messner discloses a gift certificate service system for managing sales, gifting, and usage of electronic gift certificates according to a request by a user's communication terminal

through a network, comprising: a gift certificate service server for managing purchase, gifting, and usage operations on the electronic gift certificates from the communication terminal (Abstract; column 3, lines 4-20); and a gift certificate database, accessed to the gift certificate service server, for storing electronic gift certificate information, and processing a reply to an inquiry of electronic gift certificate usage from the gift certificate service server (ibid.; column 1, lines 19-33). Messner does not expressly disclose a distinct network server, accessing the gift certificate server and accessing the user's communication terminal, but does disclose a voucher server which users' communication terminal access, and which accesses other servers, including merchants' gift certificate servers (Figure 3; column 5, lines 31-40; column 7, lines 18-43). Messner does not expressly disclose this voucher server/network server performing a client interface function concerning the purchase, gifting, and usage of the electronic gift certificates, and transmitting the user's gift certificate purchase particulars and gift certificate information for usage of the corresponding gift certificate to the communication terminal, but does disclose a personal computer or other communication terminal of the user (column 5, lines 31-40; column 7, lines 17-27; Figure 3), and official notice is taken that it is well known to transmit information on purchase particulars to users' personal computers or other communication terminals to perform client interface functions (e.g., displaying confirmation of what has been purchased, and at what price, with shipping terms if appropriate, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for a

network server to perform such a client interface function, for such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms.

As per claim 2, Messner discloses means for receiving a user's purchase request from the communication terminal (column 7, line 45, through column 8, line 58); means for settling the electronic gift certificate bought by the user, and issuing the bought electronic gift certificate to the user, when the user requests settlement (column 8, line 59, through column 9, line 17); and Messner discloses that issued gift certificate information is stored in a gift certificate database (column 9, line 66, through column 10, line 37), requiring means for storing it. Messner does not expressly disclose means for notifying the user of the gift certificate purchase particulars in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, column 9, lines 51-65), but official notice is taken that it is well known to notify users of purchase particulars (e.g., by a webpage display or email confirming that an item has been purchased, how much it cost, how it will be delivered, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have means for notifying the user of the gift certificate purchase particulars in a message format, for such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms.

Messner does not expressly disclose means for checking a settlement state of the electronic gift certificate bought by the user, but official notice is taken that it is well known to check the settlement state of a purchase, e.g., whether a credit card purchase has gone through. Hence, it would have been obvious to one of ordinary skill in the art

of electronic commerce at the time of applicant's invention to include means for checking a settlement state of the electronic gift certificate bought by the user, for at least the obvious advantages of assuring that the price of the gift certificate would be paid once and only once, and that payment or authorization was valid.

As per claim 3, Messner discloses means for receiving a user's gifting request from the communication terminal; means for receiving information on the gift certificate to be gifted and a transferee; and means for transmitting the gift certificate selected by the user to the transferee (column 5, lines 31-40; column 8, lines 36-58; column 9, lines 1-17); and means for notifying the user of the gift certificate gifting information in a message format (column 1, lines 51-65). Messner does not expressly disclose means for inquiring an existence state of the gift certificate possessed by the user of the gift certificate database, and determining the existence state, but official notice is taken that it is well known to determine the existence and/or validity of files, etc., to be transferred; this could even be considered inherent. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to inquire and determine the existence state of the certificate, for the obvious advantage of not losing money and/or creating ill will and legal liability by transferring nonexistent or invalid gift certificates.

As per claim 4, Messner discloses means for receiving a request for usage from a user of the system via a communications terminal (column 7, lines 18-43; column 9, line 66, through column 10, line 20); means for inquiring the gift certificate database of an existence state of the gift certificate possessed by the user (column 10, lines 21-37);

means for settling the price with the gift certificate and determining whether the settlement is possible (column 10, lines 28-57); means for processing the settlement on the price information when a settlement is possible (column 10, lines 28-57), updating the settlement information, and storing the updated information in the gift certificate database (column 10, lines 28-57, especially lines 38-43); and means for notifying the user of the gift certificate usage information in a message format (column 10, lines 28-57, especially lines 38-43).

It is noted that claims 2, 3, and 4 use "means for" language. Nonetheless, they are not treated as invoking 35 U.S.C. 112, sixth paragraph. If Applicant wishes to invoke 35 U.S.C. 112, sixth paragraph, Applicant should provide an explicit statement to that effect. 35 U.S.C. 112, sixth paragraph states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

### **Claims 5-9**

Claims 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of official notice. As per claim 5, Messner discloses an electronic gift certificate circulating method, comprising: (a) receiving a user's purchase request from the communication terminal (column 7, line 45, through column 8, line 58); (c) settling the electronic gift certificate bought by the user, and

issuing the bought electronic gift certificate to the user, when the user requests settlement (column 8, line 59, through column 9, line 17); and (d) storing issued gift certificate information in a gift certificate database (column 9, line 66, through column 10, line 37). Messner does not expressly disclose (e) notifying the user of the gift certificate purchase particulars and gift certificate information for usage in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, as well as notifying a recipient of a gift certificate [column 9, lines 51-65]), but official notice is taken that it is well known to notify users of purchase particulars (e.g., by a webpage display or email confirming that an item has been purchased, how much it cost, how it will be delivered, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to notify the user of the gift certificate purchase particulars and gift certificate information for usage in a message format, such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms.

Messner does not expressly disclose (b) checking a settlement state of the electronic gift certificate bought by the user, but official notice is taken that it is well known to check the settlement state of a purchase, e.g., whether a credit card purchase has gone through. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check a settlement state of the electronic gift certificate bought by the user, for at least the obvious advantages of assuring that the price of the gift certificate would be paid once and only once, and that payment or authorization was valid.

As per claim 8, Messner does not disclose that the settlement price of the gift certificate is summed with the user's communication terminal usage fee, and the summed price and fee are then settled, but official notice is taken that it is well known for shopping to be conducted with communication terminals, the prices paid being summed with the user's communication terminal usage fee (e.g., put on a mobile phone bill, or even an ISP's charges), and then settled (e.g., when the user pays his mobile phone fee). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the settlement price of the gift certificate to be summed with the user's communication terminal usage fee, and the summed price and fee then to be settled, for the obvious advantage of conveniently arranging payment through use of a communication terminal, and enabling the seller of the gift certificate to be relatively confident of receiving payment.

As per claim 9, Messner does not disclose that the message format includes SMS (short message service) and MMS (multimedia message service), but official notice is taken that SMS and MMS are both well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the message format to include one or both of SMS and MMS, for the obvious advantage of conveniently making the message available to the user.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 5 above, and further in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087469). Messner does not disclose checking the user's membership authentication state, but Ganesan

discloses that a user must be registered as a member to make payments to, or receive payments from, other members (paragraph 107), and that membership is verified for recipients of electronic gift certificates in particular (paragraphs 208-209). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check the user's membership authentication state, for at least the obvious advantages of greater security in transactions, and being able to identify users in the case of errors or possibly fraudulent or otherwise unlawful transactions.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 5 above, and further in view of Whitfield (U.S. Patent 7,209,889), and Lee (U.S. Patent 2002/0032650). Messner does not explicitly disclose that the purchase request includes information on a category of the gift certificates desired by the user, a price, and a number of sheets (although the "category" limitation may arguably be met by Messner), but it is well known for a purchase request to include information on a price of a gift certificate, as taught by Whitfield (column 14, lines 17-20). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the purchase request to include information on a price, for the obvious advantage of the user choosing a gift neither embarrassingly small nor unaffordably large.

Lee discloses a purchase request for an electronic gift certificate including a category (e.g., paragraphs 41, 42, and 54). (Note that Messner, column 7, lines 51-65, may be read as disclosing such a category, as well.) Hence, it would have been

obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the purchase request to include information on a category, for at least the stated advantage of the user demonstrating that he made an effort to tailor the gift to a recipient's taste.

Regarding the "number of sheets," the meaning of this claim element is so unclear in context that no art could be applied, nor was it reasonably possible to conduct an examination to determine whether it would have been obvious or non-obvious to one of ordinary skill in the art at the time of applicant's invention (see rejection of claim 7 under 35 USC 112, first paragraph, above).

#### **Claims 10-14**

Claims 10, 12, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of official notice. As per claim 10, Messner discloses an electronic gift certificate circulating method, comprising: (a) receiving a user's gifting request from a communication terminal (column 7, line 45, through column 8, line 58); receiving information on the gift certificate to be gifted and a transferee when the user's gift certificate, or a gift certificate purchasable by the user, is found (column 7, line 51, through column 8, line 68); and (d) transmitting the gift certificate selected by the user to the transferee (column 8, lines 36-58; column 9, lines 51-65); and Messner implies (e) updating the user's gift certificate information (e.g., by informing the user of the delivery or non-delivery of the gift certificate, column 9, lines

51-65) and storing updated information in a gift certificate database together with the transferee's gift certificate information (column 10, lines 21-57 ).

Messner does not expressly disclose (b) inquiring an existence state of the gift certificate possessed by the user of the gift certificate database, and determining the existence state, but official notice is taken that it is well known to determine the existence and/or validity of files, etc., to be transferred; this could even be considered inherent. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to inquire and determine the existence state of the certificate, for the obvious advantage of not losing money and/or creating ill will and legal liability by transferring nonexistent or invalid gift certificates.

Messner does not expressly disclose (f) notifying the user of the gift certificate gifting information in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, column 9, lines 51-65), but official notice is taken that it is well known to notify users of relevant information (e.g., by a webpage display or email confirming that an item has been purchased, how much it cost, how it will be delivered, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to notify the user of the gift certificate gifting information in a message format, for such obvious advantages as confirming to the user what gift certificate(s) he had purchased, on what terms, and to whom the certificate(s) had been sent.

As per claim 12, Messner discloses determining whether an additional gift to be transmitted together with the gift certificate is provided, and receiving corresponding information when the additional gift is found according to the determination, and transmitting the gift certificate and the additional gift to the transferee (column 9, lines 9-17 and 22-27).

As per claim 13, Messner discloses a theme card (column 9, lines 9-17 and 22-27). Messner does not disclose that the additional gift includes a bell sound, background music, and a character, but official notice is taken that it is well known for virtual cards to include characters, and sound, which may include background music, and a bell sound if desired. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the additional gift include a bell sound, background music, and a character, for the obvious advantage of making the virtual gift card a more complete, appealing, and memorable experience.

As per claim 14, Messner does not disclose that the message format includes SMS (short message service) and MMS (multimedia message service), but official notice is taken that SMS and MMS are both well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the message format to include one or both of SMS and MMS, for the obvious advantage of conveniently making the message available to the user.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 10 above, and further in

view of Ganesan et al. (U.S. Patent Application Publication 2002/0087469). Messner discloses performing a gift certificate buying process when the user presumably has no gift certificate (Abstract; column 7, line 45, through column 8, line 68). Messner does not disclose checking the user's membership authentication state between (a) and (b), but Ganesan discloses that a user must be registered as a member to make payments to, or receive payments from, other members (paragraph 107), and that membership is verified for recipients of electronic gift certificates in particular (paragraphs 208-209). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check the user's membership authentication state between (a) and (b), for at least the obvious advantages of greater security in transactions, and being able to identify users in the case of errors or possibly fraudulent or otherwise unlawful transactions.

### **Claims 15-23**

Claims 15, 17, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) in view of official notice. As per claim 15, Messner discloses an electronic gift certificate circulating method, comprising: (a) receiving a request for usage from a user of the system via a communications terminal (column 7, lines 18-43; column 9, line 66, through column 10, line 20); (b) inquiring the gift certificate database of an existence state of the gift certificate possessed by the user (column 10, lines 21-37); (c) settling the price with the gift certificate and determining whether the settlement is possible (column 10, lines 28-57);

(d) processing the settlement on the price information when a settlement is possible (column 10, lines 28-57), (e) updating the settlement information, and storing the updated information in the gift certificate database (column 10, lines 28-57, especially lines 38-43); and (f) notifying the user of the gift certificate usage information in a message format (column 10, lines 28-57, especially lines 38-43). Messner does not expressly disclose that the usage request is selected by the user from among the gift certificate information stored in the communication terminal, but does disclose delivering messages regarding a gift certificate to a recipient, by email or other means (column 9, lines 51-65). Official notice is taken that it is well known to store received emails in the communication terminals of recipients, which would result in gift certificate information being stored in the communication terminal. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the usage request to be selected by the user from among the gift certificate information stored in the communication terminal, as an obvious consequence of the use of emails.

As per claim 17, Messner does not disclose that the message format includes SMS (short message service) and MMS (multimedia message service), but official notice is taken that SMS and MMS are both well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the message format to include one or both of SMS and MMS, for the obvious advantage of conveniently making the message available to the user.

As per claim 18, Messner does not expressly disclose that the usage request is transmitted from the user's mobile communications terminal, although Messner does

disclose the use of personal digital assistants, which are mobile (column 5, lines 31-40), but official notice is taken that mobile communication terminals are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the usage request to be transmitted from the user's mobile communications terminal, for the obvious advantage of enabling the user to conveniently use a gift certificate with equipment which he is likely to have, even if away from his home, or even if he does not own a relatively immobile home computer.

As per claim 23, Messner discloses that the recipient who is using an electronic gift certificate may request usage by a usage request transmitted from an online shop which may be an online shopping mall, where the user buys a desired product and requires an online settlement (column 9, line 66, through column 10, line 53).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 15 above, and further in view of Ganesan et al. (U.S. Patent Application Publication 2002/0087469) and the anonymous article, "Ecount Introduces Incentives Program," hereinafter "Ecount." Messner does not disclose checking the user's membership authentication state between (a) and (b), but Ganesan discloses that a user must be registered as a member to make payments to, or receive payments from, other members (paragraph 107), and that membership is verified for recipients of electronic gift certificates in particular (paragraphs 208-209). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to check the user's membership authentication state between (a) and (b), for at least the obvious

advantages of greater security in transactions, and being able to identify users in the case of errors or possibly fraudulent or otherwise unlawful transactions.

Messner does not disclose performing a gift certificate buying process when the user has no gift certificate in (b) (although Messner of course discloses a gift certificate buying process, e.g., Abstract; column 7, line 45, through column 8, line 68), but “Ecount” teaches users paying into their own ecount accounts, either to be routed to other users, or for them to spend (whole article, especially paragraph beginning, “In use, ecount allows”); such paying may be viewed as buying a gift certificate. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to perform a gift certificate buying process when the user has no gift certificate in (b), for the obvious advantage of having money to spend on desired purchases, as in “Ecount.”

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 18 above, and further in view of Kasasaku (U.S. Patent Application Publication 2003/0004812). Messner does not disclose that the mobile communication terminal has a credit card function therein, but it is well known for mobile communication terminal to have credit card functions therein, as taught by Kasasaku (paragraph 15). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention for the mobile communication terminal has a credit card function therein, for the stated advantage of enabling settlement processing to be implemented within a sales outlet,

and for the obvious advantage of making credit card or credit card-like payments via a mobile phone or similar device, perhaps remotely.

Claims 20, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messner (U.S. Patent 6,370,514) and official notice as applied to claim 18 above, and further in view of Whitfield (U.S. Patent 7,209,889). As per claim 20, Messner does not disclose that the usage request is transmitted from a chain store's card terminal according to a card usage by the user, but Whitfield teaches an electronic gift certificate being transferred to the user as data to be placed on a smart card (column 14, lines 24-35; column 14, line 64, through column 15, line 3), and official notice is taken that it is well known to use cards at chain stores' card terminals to demonstrate that one qualifies for a discount or benefit, or is spending stored value (as with a gift card). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the usage request is transmitted from a chain store's card terminal according to a card usage by the user, for the obvious advantage of making use of an electronic gift certificate stored on a card, as taught by Whitfield; it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to store an electronic gift certificate on a card, for such obvious advantages as being able to conveniently present the electronic gift certificate when shopping in a brick-and-mortar store.

As per claim 21, neither Messner nor Whitfield discloses that the user's card is a membership card for membership authentication by service providers including a communication service provider and a distribution company, but official notice is taken

that it is well known for cards to be membership cards usable for membership identification by a variety of businesses. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user's card to be a membership card for membership authentication by service providers including a communication service provider and a distribution company, for the obvious advantage of making electronic gift certificates usable with known cards in widespread possession.

As per claim 22, neither Messner nor Whitfield discloses that the user's card is a brand card, but official notice is taken that brand cards are well known (for example, Examiner has been carrying brand cards qualifying him for discounts at supermarkets since well before 2000). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the user's card to be a brand card, for the obvious advantage of making electronic gift certificates usable with cards in very widespread possession.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spector (U.S. Patent 5,870,718) discloses a computer-printer terminal for producing composite greeting and gift certificate cards. Van Dusen (U.S. Patent 6,594,644) discloses an electronic gift certificate system. Gillin et al. (U.S. Patent 7,010,512) disclose a transfer instrument. Hamatani (U.S. Patent Application Publication 2002/0059112) discloses a method, system, and computer system for

processing electronic gift certificates. Parker et al. (U.S. Patent Application Publication 2003/0004997) disclose a method for online personalization of greeting cards. Lindquist (U.S. Patent Application Publication 2003/0018553) disclose a system for automatically generating a list of merchants in conjunction with the generation of a gift certificate. Walker et al. (U.S. Patent Application Publication 2006/0213985) disclose a method and apparatus for issuing and managing gift certificates.

Oh et al. (KR 2001076058-A) disclose a method for purchasing/transferring gift certificates, and purchasing goods using the certificates on the Internet. Sugiyama (JP-2001-306912-A) disclose a system and method for selling gifts with electronic gift certificates.

Chartrand ("Patents; The Success of Automated Teller Machines Leads to Other Inventions to Replace Human Processors"), Tedeschi ("E-Commerce; For the Employer, the Procrastinator and, of Course, the Merchant; Online Holiday Gift Certificates"), and the anonymous articles, "Webcertificates Allows Dads and Newlyweds to Cash in on Any Gift They Want Online or Off," "Ecount's Shop-Anywhere Webcertificates Now Available at Egreetings.com," "Excite@Home's BlueMountain.com Brings Online Greetings and Gifts Together," and "Electronic Gift Certificates now Available to Retailers, Restaurants and Other Merchants," all disclose electronic gift certificates and related matters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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